

#23



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Esswein et al.

Group: 1626

Serial No. 09/675,943, filed September 29, 2000

Examiner: L. Stockton

For: **OSTEOBLAST-SPECIFIC MITOGENS AND DRUGS CONTAINING SUCH COMPOUNDS**

**FURTHER PETITION TO REVIVE UNAVOIDABLY ABANDONED  
PATENT APPLICATION UNDER 37 CFR §1.137(a)**

Nutley, New Jersey 07110  
June 12, 2003

Mail Stop PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to revive the above-identified patent application pursuant to 37 C.F.R. §1.137(a), or in the alternative under 37 C.F.R. §1.137(b), if the

06/18/2003 AWONDAF1 00000084 082525 09675943

02 FC:1452 110.00 DA

Adjustment date: 11/18/2003 AKELLEY  
06/18/2003 AWONDAF1 00000084 082525 09675943  
02 FC:1452 110.00 CR

Serial No. 09/675,843  
Filed: September 29, 2000

Patent Office does not agree that the abandonment was unavoidable. This Further Petition is filed in response to the April 22, 2003 Decision Dismissing Petition and in augmentation to applicants' Petition filed March 17, 2003. This Further Petition is due June 22, 2003.

The application was unavoidably abandoned because applicants failed to receive an Office Action allegedly mailed by the Patent Office on July 10, 2002 and therefore could not timely respond to the Office Action. As requested in the Decision Dismissing Petition, applicants herewith provide copies of relevant docket pages and a copy of the file jacket, both showing an absence of any entry for the July 10, 2002 Office Action.

On June 10, 2002, applicants mailed to the Patent Office a Request for Continued Examination that was acknowledged by the Patent Office as being received on June 18, 2002. Applicants received no further communication from the Patent Office until January 22, 2003, when the undersigned attorney was telephoned by Examiner Laura Stockton and informed that the subject application was abandoned because the six (6) month statutory period for filing a response ended January 10, 2003. Examiner Stockton followed up with a Notice of Abandonment on January 23, 2003.

Applicants did not receive the Office Action dated July 10, 2002 until March 13, 2003 when the Office Action was sent to the undersigned attorney via facsimile. Applicants have in place a system for handling all mail received from the Patent Office. Mail forwarded to Hoffmann-La Roche Inc. ("Roche") is received by the Roche mail room. All mail from the Patent Office is forwarded to our docketing clerks who stamp the date received and enter such date and due date into Roche's computerized docketing system. The original mail is then filed in the appropriate patent file. There is no record at Roche of the Office Action having been received. There is no indication that the Office Action was ever entered into the docketing system. There is no Office Action in the patent file. Accordingly, the most likely scenario is that the Office Action was never delivered to Roche. Since Roche never received the Office Action, abandonment was unavoidable. Applicants had no intent to abandon the application.

Applicants request that the subject application be revived. Pursuant to 37 C.F.R. § 1.137(a), applicants is accompanied by:

- (1) A reply to the Office Action;
- (2) Authorization to charge the petition fee set forth in 37 C.F.R. § 1.17(l) (set forth below);
- (3) A showing (set forth above) that the entire delay in filing the reply was unavoidable;

(4) No terminal disclaimer because this is neither a design application nor an application filed before June 8, 1995; and as requested in the Decision Dismissing Petition;

(5) A statement from the practitioner (as follows): The undersigned practitioner hereby states that the Office Action allegedly mailed by the Patent Office on July 10, 2002 was not received by the practitioner and attests to the fact that a search of the file jacket and docket records indicates that the Office Action was not received; and

(6) A copy of the docket record where the non-received Office Action would have been entered had it been received and docketed. The attached docket record for the undersigned practitioner is page 3 from his July 23, 2002 docket and page 1 (listed as Page: 20) from his October 1, 2002 docket. Had the Office Action been docketed, it would have appeared as an entry marked 03-Oct-2002. No entry for 03-Oct-2002 is on the July 23, 2002 docket. The 03-Oct-2002 entry on the October 1, 2002 docket is for a Final Office Action in another application (the missing Office Action was not after final rejection and the inventor was not Heller). To protect the confidentiality of the other applications on the docket, the case numbers, title, and application numbers have been redacted; and

(7) A copy of the relevant portion of the front of the file jacket [had the Office Action been received, it would have appeared between the 5/29/02 Advisory Action and the 1/23/03 Notice of Abandonment].

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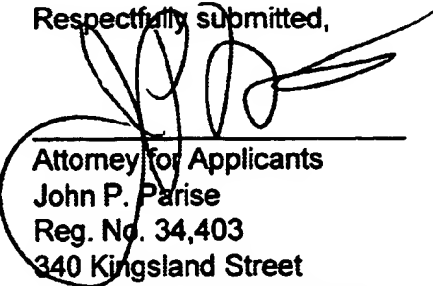
If the Patent Office determines that the delay was avoidable and denies this petition under 37 C.F.R. § 1.137(a), applicants request that the petition be considered under 37 C.F.R. § 1.137(b). Authorization is granted in such case to charge the amount of the fee required under 37 C.F.R. § 1.17(m).

In accordance with 37 C.F.R. §1.137, please charge Deposit Account No. 08-2525 for the amount of the fee due under either 37 C.F.R. § 1.17(l), in the case the Patent Office agrees with applicants that the abandonment was unavoidable, or 37 C.F.R. §1.17(m), in the case the Patent Office disagrees with applicants and determines that the abandonment was unintentional. The Commissioner is hereby authorized to charge any additional fee or credit overpayment to Deposit Account No. 08-2525. A triplicate copy of this petition is enclosed. If any additional fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 08-2525.

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Filed: September 29, 2000

Any questions regarding this communication or this application should be directed  
to the undersigned attorney of record at (201) 235-6326.

Respectfully submitted,



Attorney for Applicants  
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(201) 235-6326

/JPP  
131295

Tuesday, July 23, 2002

# Due Date List By Attorney

Page: 253

From 18-Oct-2001 To 23-Oct-2002

Attorney: JPP John P. Parise

Due Date	Action Due	Case Number	Business	Country	Application Number	Inventors
27-Sep-2002	ISSUE FEE DUE	[REDACTED]	PHARM	US	[REDACTED]	KESTER, R. F.
	Title:	[REDACTED]				
03-Oct-2002	FINAL REJECTION	[REDACTED]	PHARM	US	[REDACTED]	HELLER, R.
	Title:	[REDACTED]				
03-Oct-2002	NOTICE OF APPEAL	[REDACTED]	PHARM	US	[REDACTED]	HELLER, R.
	Title:	[REDACTED]				
15-Oct-2002	OFFICE ACTION	[REDACTED]	PHARM.	US	[REDACTED]	BROCKHAUS, M.
	Title:	[REDACTED]				

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## Due Date List By Attorney

From 07-Feb-2002 To 01-Jan-2003

Attorney: JPP John P. Parise

Due Date	Action Due	Case Number	Business	Application Country Number	Inventors
25-Sep-2002	FILE USPTO	[REDACTED]	BM-P	US	
	Title:	[REDACTED]			
		BIOTINYLATION			
	Remarks:	MAILED 9/20/02			
27-Sep-2002	ISSUE FEE DUE	[REDACTED]	PHARM	US	ACKERMANN, J.
	Title:	[REDACTED]			
	Remarks:	MAILED 9/20/02			
27-Sep-2002	LTR TO BASLE	[REDACTED]	PHARM	US	ACKERMANN, J.
	Title:	[REDACTED]			
30-Sep-2002	PHARMA PATENT COMMITTEE	[REDACTED]	PHARM	US	KLAUS, M.
	Title:	[REDACTED]			
	Remarks:	BASLE MEMO 9/9/02 REVIEW PATENT FAMILIES FILED BETWEEN 1987 AND 1996.			
03-Oct-2002	FINAL REJECTION /	[REDACTED]	PHARM	US	HELLER, R.
	Title:	[REDACTED]			
03-Oct-2002	NOTICE OF APPEAL /	[REDACTED]	PHARM	US	HELLER, R.
	Title:	[REDACTED]			
12-Oct-2002	PATENT DATA	[REDACTED]	PHARM	US	DONG, E.
	Title:	[REDACTED]			

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TITLE **DSTEROBLAST-SPECIFIC MITOGENS AND DRUGS CONTAINING SUCH COMPOUNDS**

ASSIGNEE <i>Roche Diagnostics GmbH</i>		ASSIGNMENT RECORDED <i>01/28/00</i> (Parent) REEL <i>011118</i> FRAME <i>0606</i>	
FOREIGN PRIORITY DATA COUNTRY <i>PCT</i>	FILING DATE <i>09130198</i>	SER. NO. <i>PCT EP98/06214</i>	
COUNTRY <i>EUROPE</i>	FILING DATE <i>10102197</i>	SER. NO. <i>97117124.4</i>	
COUNTRY	FILING DATE	SER. NO.	
PRIORITY CLAIMED <i>10/2/97 &amp; 09/30/98</i>	CERT. COPY FILED <i>Serial filed</i>		
FOREIGN FILING LICENSE	GRANTED		

FOR ADDITIONAL FOREIGN FILING LICENSES - SEE INSIDE FOLDER

OFFICE ACTION	MAILING DATE	RESPONSE DUE DATE	RESPONSIVE PAPER	MAILING DATE	RI
			Divisional "A"	09/29/00	9/1
			Preliminary Amendment "B"	11/14/00	11/
/			Request for Corrected Filing Rept	11/29/00	11/
			Info. Sheet. Stmt	11/29/00	12/
Restriction	06/28/01	07/28/01	Amendment "C"	07/30/01	6/
Office Action	09/14/01	09/15/01	Communication	09/13/01	9/
Office Action	09/26/01	12/26/01	Amendment (no fee)	12/20/01	1/
Office Action - FINAL	02/05/02	05/05/02	Amendment After Final Rejection	5/11/02	5/
Advisory Action	5/27/02		RCE with 2 Mo. Ext. of Time	6/10/02	6/
Notice of Abandonment	1/23/03		Request to Reopen Unavoidably		
			Withdrawal of App. & Amendment	3/17/03	3/

**U.S. PATENT  
HOFFMANN - LA ROCHE INC.  
NUTLEY, NJ 07110**

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